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February 3, 2003

Examiner Susan D. Coe
U.S. Patent & Trademark Office
Commissioner for Patents
Washington, D.C. 20231

Re: ANTI-ULCER PHARMACEUTICAL COMPOSITION AND THE
PREPARATION THEREOF

Applicant: Feng-Nien Ko et al.
Application No.: 09/522,434
Filing Date: March 9, 2000
Our Ref.: 11544-003001

Dear Examiner Coe:

I appreciate your spending time to discuss the Advisory Action with me over the phone on January 29, 2002. This is a follow-up to our discussion, which has been most useful:

1. We have proposed amending claim 1 by inserting the language "constitutes the sole source of compounds from American ginseng." The proposed amendment does not narrow the claim scope for the following reasons.

Claim 1 covers an anti-peptic ulcer composition (see the preamble) comprising (1) an American ginseng extract prepared by a specific process (see the wherein clause), and (2) a carrier. A fair reading of this claim, in view of the specification, compels the conclusion that it covers a composition that contains only one American ginseng extract as recited in claim 1. Example 5 of the specification provides animal results showing that such an extract possesses anti-peptic ulcer activity. Given these results and the "treating peptic ulcer" language in the preamble, a skilled person would conclude that the composition of claim 1 does not contain another American ginseng extract prepared by a process different from that recited in the wherein clause. In other words, the proposed amendment, made in response to the final office action, merely serves to promote clarity.

2. We now turn to a statement in the Advisory Action: "the amendment would raise new 112 2nd issues and would require a new search."

As the proposed amendment might not be the best way to make it clear that claim 1 does not contain American ginseng extracts other than the recited extract, we are willing to consider any suggestion you might have to resolve this semantic issue. On



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the other hand, a new search clearly is not required in view of the proposed amendment. This amendment contains only one searchable key term, i.e., "American ginseng." Since this term is recited in original claim 1, it must have already been used by you in the previous search and, as a result, no new search is required. The situation is analogous to changing the open-ended phrase "comprising" to the closed-ended phrase "consisting of," which does not necessitate a new search. Here, we have amended claim 1 to make it clear that the term "American Ginseng extract" is closed-ended, i.e., the claimed composition does not contain American Ginseng extracts other than what is recited.

For the above reasons, the proposed amendment does not require a new search even if it has narrowed claim 1 (which we do not concede).

3. As no new search is required, we implore you to review our response to the final office action. The response contains only two pages of arguments and there are only two claims to be considered, i.e., claim 1 and claim 11 dependent from it. During the telephone discussion, you proposed that we filed an Request for Continued Examination. However, as no new search is required, we are entitled to having the response considered on the merits. Further, given the simplicity of the pending issues, it would save the resources of the U.S. Patent and Trademark Office if you could resolve them now rather than later.

I will call you in a day or two after you have had an opportunity to review this letter. If necessary, I can prepare and file a response to the final office action and the advisory action, reiterating the points raised herein.

Finally, please forward a copy of this letter to Preliminary Examiner Lankford, if it would expedite bringing this application to a close.

Very truly yours,

Y. Rocky Tsao

Y. Rocky Tsao, Ph.D., J.D.
Registration No. 34,053

YRT/mtr